

REMARKS

The Applicants have studied the Office Action dated December 31, 2003 and have made amendments to the claims to distinctly claim and particularly point out the subject matter which the Applicants regard as the invention. Claims 7-16 and 23 have been cancelled without prejudice. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-6 and 17-22 are pending. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- objected to the drawings because of the presence of an informal drawing;
- rejected claims 18 and 21 under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis;
- rejected claims 1-10, 15-18 and 20-23 under 35 U.S.C. § 102(e) as being anticipated by Bahar (U.S. Pub. No. 2002/0019852);
- rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) in view of DiGiorgio et al. (U.S. 6,418,420); and
- rejected claims 11 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) in view of DiGiorgio et al. (U.S. 6,418,420) and further in view of Bell (U.S. 6,600,902).

Objection to the Drawings

As noted above, the Examiner objected to the drawings because of the presence of an informal drawing. The Applicants submit new formal drawings herewith, in accordance with the rules and regulations regarding drawings. Therefore, the Examiner's objection to the drawings has been overcome.

Objection to Claims 18 and 21

As noted above, the Examiner rejected claims 18 and 21 under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis. The Applicants have amended the claims 18 and 21 to correct this antecedent bases. Therefore, the Examiner's rejection to the claims 18 and 21 has been overcome.

Rejection under 35 U.S.C. §102(e) over Bahar

As noted above, the Examiner rejected claims 1-10, 15-18 and 20-23 under 35 U.S.C. § 102(e) as being anticipated by Bahar (U.S. Pub. No. 2002/0019852). The Applicants respectfully traverse this rejection below.

The Applicants' invention is directed towards obtaining personal identifying information from a person receiving information content via an output device and sent back to the source of the information, e.g., the sender. The personal information such as that in VCARD format is entered by the person receiving the document from a smart card or similar device. The present invention offers confirmation to users of computer communication systems as to the identity of the recipient of information they have transmitted over the system. See Abstract of Applicants' specification.

The Applicants' invention is further directed towards the generation of a record showing a party retrieving a document sent to a remote location over a two-way communication system, directly in response to standard identifying information, without the corroboration or verification of a password and without any need for encryption. The invention may be used with any kind of two way communication system, whether local or worldwide through the Internet, and including wireless systems, circuit switched telephone systems, cable or fiber optic systems. The invention allows a record or trail to be established by standard identity data, leading to the party who was the one actually accessing or retrieving a remotely delivered document. This record or trail is particularly useful as it can be used with any document, in any form, whether in a data file such as a word processing file or data base file or spread sheet file, and whether or not encrypted, encoded, or otherwise limited to named identified parties permitted access

to the document. The present invention may be applied to any remote document delivery system, such as for example, a printer, facsimile, or computer processor having a data store or a display. See Summary of the Invention of Applicants' specification.

The Bahar reference is directed towards a method and system for confirming proper receipt of an e-mail file sent by a sending party over a communications network such as the Internet and intended to be received by a target party. The e-mail file sent by the sending party is properly or improperly delivered to a recipient's e-mail address and stored in a data storage location of a recipient computer system. When the accessing party, who may or may not be the intended target party, accesses either the e-mail file itself or an e-mail processing program or user account, various recipient information, including identity information associated with the accessing party, is discovered from the recipient computer system and included in a generated confirmation of receipt notice. The confirmation of receipt notice is subsequently and automatically return transmitted to the sending party. In one embodiment, an attachment file is transmitted together with the e-mail which operates to discover and obtain the recipient data, generate the confirmation of receipt notice, and transmit the confirmation of receipt notice to the sending party. In this manner, the sending party can determine whether the accessing party who actually received and was notified of the e-mail file was, in fact, the intended target party, and thereby determine whether delivery was proper. See Abstract of the Bahar reference.

Thus, the Bahar reference provides a system for replying to an email with a confirmation receipt notice, wherein the notice includes information identifying the recipient of the email. This allows the sending party to determine whether the intended recipient received the email and whether the delivery was proper.

With regards to independent claim 1, however, the Bahar reference does not disclose the reception of a file with authentication data, the reception of identification information from a recipient and, specifically, the comparison of the two received items in order to determine whether a match exists between the two items, as described in the

independent claim 1 of the Applicants' invention. Further, the Bahar reference does not disclose the sending of the file for output if the match occurs and the sending of a notification that the file was sent. Claim 1 is reproduced in relevant part below:

an interface to a receiver for receiving a file with authentication data from a remote system;

an input for receiving identification information from an authenticated recipient;

a comparator for comparing if said identification information from said authenticated recipient is matched to at least part of said authentication data in said file;

an interface to an output for sending said file to an output device if said identification data from said authenticated recipient is matched to at least part of said authentication data in said file; and

an interface to transmitter for sending a notification of the output of said file to said output device to at least one designated party if said identification data from said authenticated recipient is matched to at least part of said authentication data in said file.

Thus, nowhere in the specification does the Bahar reference make any mention of the comparing of a received file having authentication data to received identification information from a recipient in order to determine whether a match exists between the two items. Accordingly, for this reason, the Applicants' invention is distinguishable over Bahar .

Therefore, for the reasons stated above, the Bahar reference does not describe, teach nor suggest the recited elements of independent claim 1. Therefore, the Examiner's rejection of this claim should be withdrawn.

Dependent claims 2-6 depend from independent claim 1. Since dependent claims contain all the limitations of the independent claims, claims 2-6 distinguish over the

reference above. Therefore, the Examiner's rejection of these claims should be withdrawn.

With regards to independent claims 17 and 22, the Bahar reference does not disclose the reception of a file, the reception of identification information from a recipient, producing a copy of the file and, specifically, the production and transmission of a record memorializing the identification information of the file that was copied, as described in the independent claims 17 and 22 of the Applicants' invention. Claim 17 is reproduced in relevant part below:

*storing said document in said presentation device;
... inputting at said presentation device, identifying data
indicative of the identification of a party accessing the document;
... producing a copy of said document, ... and
as a fourth step, producing a record of said the identifying
data used to produce said print command, and transmitting said record*

Thus, nowhere in the specification does the Bahar reference make any mention of producing and transmitting a record memorializing the received identification information of a received file that was copied. Accordingly, for this reason, the Applicants' invention is distinguishable over Bahar .

Therefore, for the reasons stated above, the Bahar reference does not describe, teach nor suggest the recited elements of independent claims 17 and 22. Therefore, the Examiner's rejection of these claims should be withdrawn.

Dependent claims 18-20 depend from independent claim 17. Since dependent claims contain all the limitations of the independent claims, claims 18-20 distinguish over the reference above. Therefore, the Examiner's rejection of these claims should be withdrawn.

Rejection under 35 U.S.C. §103(a) over Bahar and DiGiorgio

As noted above, the Examiner rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Bahar (U.S. Pub. No. 2002/0019852) in view of DiGiorgio et al. (U.S. 6,418,420). The Applicants have cancelled claims 12-14 without prejudice, rendering moot the Examiner's rejection of these claims.

Rejection under 35 U.S.C. §103(a) over Bahar, Giorgio and Bell

As noted above, the Examiner rejected claims 11 and 19 under 35 U.S.C. § 103(a) as being unpatentable over DiGiorgio et al. (U.S. 6,418,420) and further in view of Bell (U.S. 6,600,902). The Applicants have cancelled claim 11 without prejudice, rendering moot the Examiner's rejection of this claim.

With regards to dependent claim 19, which depends from independent claim 17, the Applicants respectfully overcome this rejection below. As noted above, the independent claim 17 distinguishes over the Bahar reference. That is, the Bahar reference does not describe, teach nor suggest the recited elements of independent claim 17. Therefore, the independent claim 17 distinguishes over any combination including the Bahar reference, including a combination of the DiGiorgio reference, the Bell reference and the Bahar reference. Dependent claims contain all the limitations of the independent claims. Thus, since claim 19 depends from independent claim 17, claim 17 distinguishes over the references above. Therefore, the Examiner's rejection of this claim should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly,

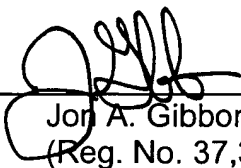
Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Date: March 26, 2004

By: 
Jon A. Gibbons
(Reg. No. 37,333)

Fleit, Kain, Gibbons, Gutman & Bongini, P.L.
One Boca Commerce Center, Suite 111
551 N.W. 77th Street
Boca Raton, FL 33487
Telephone No.: (561) 989-9811
Facsimile No.: (561) 989-9812

PLEASE Direct All Correspondence to Customer Number 23334